



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,403	07/15/2004	Mitsutoshi Terada	255884US6PCt	2793
22850 7590 05/03/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER PATEL, GAUTAM	
			ART UNIT 2627	PAPER NUMBER
			NOTIFICATION DATE 05/03/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/501,403

Applicant(s)

TERADA ET AL.

Examiner

Gautam R. Patel

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-15-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-10 are pending for the examination.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

Election/Restriction

3. Claims 6-7 and 9-10 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to non-elected embodiments and/or figs. 28 and 30. Election was made with traverse of claims 1-4 related to invention A.

Applicant's election with traverse of group b in Paper dated 2/5/07 is acknowledged.

The traversal is on the ground(s) that "under this standard [national stage PCT], Applicants respectfully submit that claims 1-5 and 8 are drawn to single general inventive concept." ... "Applicants respectfully submit that the Restriction Requirement should be withdrawn at least with respect to inventions A and B, and that Claims 1-5 and 8 be examined together."

Applicants arguments are found persuasive and claims 1-5 and 8 will be examine together.

The requirement is still deemed proper and is therefore made **FINAL**.

NOTE: Action on claims 1-5 and 8 follows.

Drawings/Objection

4. The drawings are objected for following reasons:

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, "a normal record and playback sub-area, a rewriting replacement sub-area, and a replacement management sub-area" must be shown or the features cancelled from the claims.

No new matter should be entered.

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of following:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be *accompanied by a marked-up copy of one or more of the figures being amended, with annotations*. Any replacement drawing sheet *must be identified in the top margin as "Replacement Sheet"* and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).*

a proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Correction may not be held in abeyance.

Correction are required.

Objection to Specification

5. The disclosure is objected for following reasons.

The title of the invention is neither precise nor descriptive. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. It is recommended that the title should reflect the gist of or the improvement of the present invention.

Correction is required.

Claim Rejections - 35 U.S.C. § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

Claim 8 does not define what is being claimed but simply states what a recording medium has. It is not even clear if claim pertains to an apparatus or a method as such. Even though claim starts out as a method it has nor method steps.

Art Unit: 2627

7. Claim 8 is rejected under 35 U.S.C. §101 as being hybrid claims. This claims is directed to neither a “process” nor a “machine” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101.

Claim Objections

8. Claim 1-5 objected for following reasons.

It is not clear what the Applicants are trying to claim here. Claim 1 simply states that it is a recording medium with different data areas no other component has been described. Also “rewriting replacement area” or “replacement management sub-area” has not been shown or adequately defined any place in specification or drawings.

Corrections are required.

Claim Rejections - 35 U.S.C. § 112

9. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-5 and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

“a rewriting replacement sub-area” and ‘a replacement management sub-area” in which data that is to be updated” required by the claims is not described in the specification.

On page 6, lines 2-17 the specification mentions “main data area that is write-once recordable section. After few lines specification states “that a rewriting replacement sub-area into which rewritten data is recorded. It is not clear at all how write-once area is able to re-write data into the same space. If this area is different is neither defined nor explained. Also drawings do not show ANY area that is rewritable. Accordingly, the specification does not explain to one of ordinary skill in the art at the time of the invention, how to make and or use the invention comprising the claimed re-write are in a disk which defined as write-once.

11. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, simultaneously claims “a write-once disk” which has rewriting replacement sub-area AND “a replacement management sub-area” is confusing and unclear. Also it not clear what is the difference between “PLAYBACK-ONLY SECTION” & “WRITE-ONCE SECTION”, since both these names are different names for the same concept [ROM] in figure 1.

Claim Rejections - 35 U.S.C. § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Fukasawa et al., US. patent 6.615,363 (hereafter Fukasawa).

As to claim 1, Fukasawa discloses the invention as claimed [see Figs. 4-5 and 9] including a main data area, a management/control area, and a replacement management sub-area which is updated comprising:

a recording medium having a main data area that is a write-once recordable section in which data is writable once, and a management/control area in which management/control information for recording and playing back data on the main data area is recorded, wherein the main data area includes: a normal record and playback sub-area in which data is recorded and played back; a rewriting replacement sub-area into which rewritten data is recorded in response to a request to rewrite the data recorded in the normal record and playback sub-area; and a replacement management sub-area [area 40; col. 5, lines 44-53; col. 9, lines 36-48] in which replacement management information between the data that is to be updated in the normal record

Art Unit: 2627

and playback sub-area according to a rewrite request and the rewritten data that is recorded in the rewriting replacement sub-area in response to the rewrite request is recorded [col. 3, line 62 to col. 4, line 15; col. 5, lines 13-53; col. 11, lines 43-59; and col. 12, lines 25-29].

13. The aforementioned claim 2, recites the following elements, inter alia, disclosed in Fukasawa:

the sizes of the rewriting replacement sub-area and the replacement management sub-area are defined by the management/control information recorded in the management/control area [col. 3, line 62 to col. 4, line 15; col. 5, lines 13-53; col. 11, lines 43-59; and col. 12, lines 25-29].

14. The aforementioned claim 3, recites the following elements, inter alia, disclosed in Fukasawa:

the management/control information recorded in the management/control area includes information indicating whether or not the rewriting replacement sub-area and the replacement management sub-area are available [col. 3, line 62 to col. 4, line 15; col. 5, lines 13-53; col. 11, lines 43-59; and col. 12, lines 25-29].

15. The aforementioned claim 4, recites the following elements, inter alia, disclosed in Fukasawa:

the management/control area is a write-once recordable section in which data is writable once, and includes a management/control-information replacement sub-area for updating the management/control information for the rewriting replacement sub-area and the replacement management sub-area [col. 3, line 62 to col. 4, line 15; col. 5, lines 13-53; col. 11, lines 43-59; and col. 12, lines 25-29].

16. The aforementioned claim 5, recites the following elements, inter alia, disclosed in Fukasawa:

a recording apparatus for a recording medium having a write-once recordable section in which data is writable once, the write-once recordable section including a main data area and a management/control area in which management/control information for recording and playing

Art Unit: 2627

back data on the main data area is recorded, said recording apparatus comprising: writing means for writing data; and formatting control means for causing the writing means to record the management/control information in the management/control area so as to form in the main data area: a normal record and playback sub-area in which data is recorded and played back;

a rewriting replacement sub-area into which rewritten data is recorded in response to a request to rewrite the data recorded in the normal record and playback sub-area; and a replacement management sub-area in which replacement management information between the data that is to be updated in the normal record and playback sub-area according to a rewrite request and the rewritten data that is recorded in the rewriting replacement sub-area in response to the rewrite request is recorded [col. 3, line 62 to col. 4, line 15; col. 5, lines 13-53; col. 11, lines 43-59; and col. 12, lines 25-29].

17. A search based on the best understanding of the claims has been made to find the most pertinent art, but no statement about invention will be appropriate at this time regarding the allowableness of claims 8 and no art rejection will be made in this office action regarding the claims 8, due to the speculation required to interpret the claims because of their indefiniteness under 35 U.S.C. 112, 1st and 2nd paragraphs as noted above (see In re Steele, 134 USPQ 292).

Other prior art cited

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Tanaka et al. (US. Patent 6168321).
- b) Ito et al. (US. patent 6160778)
- c) Otsuka (US. patent 6094723)
- d) Gotoh et al. (US. patent)
- e) Komori (US. patent 6182004). **Discloses concept of ROM rewriting.**

Contact information

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is 571-272-7625. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2600) where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dwayne Bost, who can be reached on (571) 272-7023.

Any inquiry of a general nature or relating to the status of this application should be directed to the Electronic Business Center whose telephone number is 866-217-9197 or the USPTO contact Center telephone number is (800) PTO-9199.



GAUTAM R. PATEL
PRIMARY PATENT EXAMINER

Gautam R. Patel
Primary Examiner
Group Art Unit 2627

April 25, 2007